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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,763	02/04/2004	David E. Grober		3650

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EXAMINER

MAHONEY, CHRISTOPHER E

ART UNIT PAPER NUMBER

2851

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/771,763

Applicant(s)

GROBER, DAVID E.

Examiner

Christopher E. Mahoney

Art Unit

2851

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,12-16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-11,17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

### ***Election/Restrictions***

Applicant's election without traverse of Group 1 and Species B1 in the reply filed on June 25, 2005 is acknowledged.

The applicant has indicated that claims 1-14, 17 and 19-20 read on the elected species. The examiner disagrees. For example, the examiner is unaware of a sensor which emits paints (see claim 5). Additionally, the applicant does not have sufficient disclosure in the specification to support a claim of a sensor which emit paint. Claims 1-4, 7-11, 17, and 19-20 currently read on the elected species.

Art Unit: 2851

Additionally, claims 13-14 were inadvertently listed as group I invention rather than Group II invention. However, claims 12-14 are also directed to a method using joint angles to determine position.

The examiner will consider rejoining the non-elected upon allowance of the application.

### ***Information Disclosure Statement***

The applicant is reminded of the duty of to disclose information material to patentability. See MPEP 2000 and 37 CFR 1.56.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-9 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for stabilizing a platform on a buoy, does not reasonably provide enablement for remotely controlling the device(s) or operating the devices while on the buoy. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 17 recites the broad recitation actuators, and the claim also recites motors, gears, magnets, etc. which is the narrower statement of the range/limitation.

Additionally, claim 17 recites "including but not limited to". Claims recite what an applicant's rights are limited to. To state "not limited to" makes it unclear what the scope of the invention is. The applicant should review MPEP 2111.03 which discusses use of the terms, "comprising" "consisting", "consisting essentially of".

Art Unit: 2851

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 7-11, 17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Royalty (U.S. Pat. No. 6,859,185). Royalty teaches a stabilized buoy platform (col. 1, lines 10-14) for mounting a stabilized platform 22 on the buoy, a stabilizing system 30/36/38 mounted on the platform for stabilizing a singular or plurality of devices (antenna) from the movements of the buoy in three directions which include pitch, roll and azimuth, and at least one tool (antenna) mounted on the stabilizing system. An antenna both senses and transmits electromagnetic radiation. Any programming which controls the stabilization are commands from a person or computer. Any platform which is mounted on a vehicle is capable of being removed and is therefore removable. The applicant is directed to review figures 1-3.

Claims 1, 3, 4, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dodge (U.S. PAT. NO. 4,626,852). Dodge teaches a stabilized buoy platform for mounting a stabilized platform 104 on the buoy 10, a stabilizing system (figure 4) mounted on the platform for stabilizing a singular or plurality of devices (lamp and solar cells) from the movements of the buoy in three directions which include pitch, roll and azimuth, and at least one tool (lamp and solar cells) mounted on the stabilizing system.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Royalty (U.S. Pat. No. 6,859,185) in view Direct TV®. It is notoriously well known that antennae may be used to receive television (digital image) signals. Direct TV® is just one source for such a service and has been providing such services for at least a decade. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features taught by Direct TV® for the purpose of providing television signals.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Royalty (U.S. Pat. No. 6,859,185) in view Edmondson (U.S. Pat. No. 2,172,440). Royalty teaches the salient features of the claimed invention except for automatic braking of the shafts. Edmondson teaches that it was known to provide automatic motor braking on the shafts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features taught by Edmondson for the purpose of automating cessation of unwanted movement.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2851

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E. Mahoney whose telephone number is (571) 272-2122. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**CHRISTOPHER MAHONEY  
PRIMARY EXAMINER**